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No. 83-2047

In the
Supreme Court of the United States
OCTOBER TERM, 1983

MTD PRODUCTS INC.,
Petitioner,

vs.

RADIO STEEL & MFG. CO.,
Respondent.

On Petition For A Writ Of Certiorari To The United States Court of Appeals For the Federal Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

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QUESTIONS PRESENTED

Central to the Petitioner's present theory of relief is this Court's 1938 decision in *Lincoln Engineering* v. *Stewart-Warner,* 303 U.S. 545 (1938). Petitioner contends that the wheel-barrow of the Tonelli Patent No. 3,282,600 (the '600 patent) is characterized by a single novel feature and that since the patent claims cover the entire wheelbarrow combination they are invalid in view of the holding in *Lincoln Engineering* that where the invention was only an improvement in a single element of a combination of old elements, "a patent claiming the entire combination was void as claiming more than the applicant invented". Petitioner contends further that instead of accepting this invalidity defense, both the trial court and the Court of Appeals for the Federal Circuit 'disregarded' or 'overruled' the *Lincoln Engineering* decision.

Petitioner's arguments are unsound because both Courts did consider *Lincoln Engineering* and found it not to be controlling. The reason for this is that the record is utterly devoid of any support for Petitioner's argument that patentability of the claimed invention, if any, rests in a single improved feature, the "channel-shaped end" of the brace member.

Petitioner has not raised a proper issue warranting this Court's attention and is not entitled to the requested relief.

STATEMENT UNDER RULE 28.1

Respondent, Radio Steel & Mfg. Co., Inc. is an independent corporation having no parent, subsidiary, or affiliate companies.

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BRIEF FOR RESPONDENT IN OPPOSITION

STATEMENT OF THE CASE

This is a suit brought by Respondent (RADIO) against Petitioner (MTD) for infringement of its Tonelli patent, No. 3,282,600. Following a non-jury trial, the District Court held the patent valid but not infringed, in essence, on the ground that the accused wheelbarrow structure included "filler strips", an element not specifically delineated in the claims. Upon appeal to the Federal Circuit, the holding of validity was affirmed but the finding of non-infringement was reversed.

A. The Parties And The Patent

Respondent is the owner of the Tonelli patent in suit which is directed to a wheelbarrow structure having the desirable features of high operational strength and compact break-down packaging.

Petitioner is a manufacturer of wheelbarrows and other products. Petitioner discontinued manufacturing its prior non-infringing wheelbarrow line in 1976; thereafter, in 1980, it commenced production of the accused infringing line of wheelbarrows.

B. The Proceedings In The District Court

Radio introduced testimony of six witnesses, including its Senior Design Engineer, Mr. Micheleau, its technical and patent expert, Mr. Hobbs, and three employees of MTD. The witnesses described the interaction and cooperation of the various elements comprising the claimed wheelbarrow, and particular emphasis was placed on the fact that the "channel-shaped" ends of the cross brace were not critical features of the combination.

MTD offered no case in defense, relying, instead, upon the cross-examination of witnesses called during Radio's case-in-chief. Specifically, MTD adduced nothing during trial in support of its assumption, so critical to its *Lincoln Engineering* defense, that the channel shape is the essence of the invention.

MTD did, however, argue the *Lincoln Engineering* defense opining that the only new element of the claimed wheelbarrow combination was the "channel-shaped" ends of the brace member, and that in claiming the entire combination, the patentee had claimed too much. The District Judge recognized MTD's *Lincoln Engineering* de-

fense (A24) but could not agree with MTD's conclusion that the invention was limited to the channel-shaped brace member finding, rather, that "it is the totality of all the elements and their interaction with each other which is the inventor's contribution to the art of wheelbarrow making" (A38).

Neither party introduced evidence or otherwise argued the "filler strips" issue upon which the District Court ultimately relied for its non-infringement finding as neither party considered filler strips to be material to any issue in this case.

C. The Proceedings Before The Court of Appeals

The Court of Appeals reversed the District Court's holding of non-infringement on the ground that the "means language in claim 2 therefore covers the filler strips" (A16) and, further, that "an accused device that contains the same feature as the patented device cannot escape infringement because in it that feature performs an additional function it does not perform in the patented device" (A17). MTD does not contest this determination in the present Petition to this Court.

MTD's *Lincoln Engineering* defense was also reviewed by the Court of Appeals for the Federal Circuit. In pertinent part, the Court of Appeals commented:

> "MTD argues that under *Lincoln Engineering,* the '600 patent is invalid since the only novel element of the invention is the channel-shaped portion at the ends of the cross brace, but the claims cover an entire wheelbarrow . . . (A8)
>
> Contrary to MTD's argument, the channel-shaped portion of the cross brace is not the essence of the invention or its only novel element.

> In sum, as the district court held, the '600 patent "descri[bed] . . . a new and improved complete wheelbarrow (A9)."

The Court of Appeals concluded, as did the trial judge, that "claim 2 meets the statutory requirement" of section 112, and that *Lincoln Engineering* does not require the invalidation of the claims of the '600 patent (A9.10).

ARGUMENT

Petitioner's claim for relief before this Court is premised upon its belief that the lower Courts either ignored or overruled *Lincoln Engineering* and, further, that the patent in suit must necessarily fall under the rule of that case. The Petitioner raises the question whether *Lincoln Engineering* has continuing vitality following enactment of the 1952 revisions to the patent statute, particularly 35 U.S.C. § 112.

Whatever the academic merit of these questions propounded by Petitioner, the Petitioner has failed to make a record or establish a factual basis permitting this Court to properly reassess the law of *Lincoln Engineering* in view of the subsequent amendments to the patent laws. Thus, Petitioner's reliance on *Lincoln Engineering* is unfounded for the simple reason that the record is utterly devoid of any factual support for its contention that the invention, if any, pertains only to the single "channel-shape" limitation of the claims rather than to the entire claimed combination. And, further, Petitioner has misrepresented the opinions of the District Court and the Court of Appeals to the extent that it characterizes these decisions as ignoring or overruling the *Lincoln Engineering* precedent.

I. The Critical Element Required To Invoke Lincoln Engineering Is Lacking

As recognized by the Court of Appeals, *Lincoln Engineering* stands for the proposition that "where the invention was only an improvement in a single element of a

combination of old elements, a patent claiming the entire combination was void as claiming more than the applicant invented" (A8). Petitioner has repeatedly attempted to shoe-horn the present case into a *Lincoln Engineering* fact pattern by arguing that if there is any invention at all in the '600 patent, it resides in the channel-shaped end of the brace member:

> "For the purpose of discussing the application of the *Lincoln Engineering* decision to this case, *it may be assumed* that Tonelli, in making the patented wheelbarrow, invented the improvement of the *channel shaped sections* . . ." (emphasis original and added) (Petition For Writ of Certiorari, pg 9)

The difficulty with Petitioner's position is that the record simply will not support this proposition and, therefore, *Lincoln Engineering* is not applicable.

II. The Record Clearly Reflects That The Invention Resides In A Combination Of Elements Which Cooperate To Form An Overall Wheelbarrow Structure of High Strength And Of Compact Size For Shipping; MTD's 'Point Of Novelty' Approach Is Entirely Unsupported By Tne Record

MTD points to nothing, absent counsel's own argument, in support of its contention that the channel shape is the essence of the invention. All pertinent evidence — the Tonelli patent disclosure, the prosecution history in the Patent Office, the resulting Tonelli claims, and the testimony at trial — establishes that several elements cooperate to form the patentable combination.

The Tonelli patent disclosure (A53-58) and claims (A57, 58) recite in detail the various elements of the combination which:

> "are thus interconnected one to another in the assembly to provide a strong and fixed assembly having strength and stability as great as, if not greater than, that capable of being achieved by pre-assembled units of that type heretofore produced" (A57, col. 5, lines 48-53).

It is specifically made clear that the bowl serves as part of the means for securing the respective handle pieces in assembly (Claim 10, A58). The patent disclosure sets forth with particularity the interconnections and interrelationships of the handle pieces 40a,b, the bumper plate 46, the cross brace member 72, the inverted V brace 92, the legs 60, and the bowl 10 which combine to form a strong integrated support structure.

Nothing in the '600 patent disclosure suggests that the channel-shaped ends constitute the invention, and this was most certainly recognized by the Examiner. In preparing his first action on the Tonelli application, the Examiner cited the Smith '975 patent (A66) and then stated that Smith was cited "because it shows a two-piece wheelbarrow handle and *channel-like connecting members 16, 17*." If the Examiner had considered the invention to reside in a channel for interconnecting wheelbarrow handle pieces, then he most certainly would not have allowed the '600 claims.

Nor is Petitioner's narrow definition of the invention supported by the trial testimony. Both Micheleau and Hobbs made reference to the respective elements disclosed and claimed in the '600 patent, and they traced the distribution of forces in response to the application of a load. (Appendix on Appeal, pages 199-203; 254-55). In fact Micheleau, having determined that the brace member functions to "contain these handles to keep them

from flexing or separating or breaking, in an up and down motion," concluded that the channel "has no significance" and "really doesn't function at all in this load bearing capacity." (Appeal App. 205,6). Hobbs similarly concluded that the flat-ended MTD structure "functions and gives the same result" as the channel-shaped arrangement shown in the '600 patent (Appeal App. 252) and, therefore, the substitution of MTD's flat-ended cross brace member did not change Hobb's opinion regarding the application of the Tonelli claims to the MTD wheelbarrow. (Appeal App. 269).

Even the testimony of Petitioner's own employees does not support its argument that the channel-shape is critical to, or the essence of, the Tonelli '600 patent. Mr. Thon (MTD Manager of Product Development) could attribute no advantage to the channel-shape other than "it holds the two pieces together" for alignment (Appeal App. 161) and Mr. Plamper (MTD Chief Engineer) affirmed that the channel isn't necessary to have a good product and, significantly, "we think (our product) is all right as it is" (i.e. without channel-shaped brace members). (Appeal App. 180,1).

As previously noted, the District Court was not unaware of Petitioner's contention that "plaintiff's invention", if any, is limited to the channel-shaped sections (A25). The Trial Judge declined to so narrowly construe the invention; choosing, instead, to apply the correct statutory "subject matter as a whole" standard, 35 U.S.C. § 103:

> "the '600 patent will be analyzed on the basis of its asserted description of a new and improved *complete* wheelbarrow" (emphasis added) (A25).

> "It is the *totality of all the elements* and their interaction with each other which is the inventor's contribution to the art of wheelbarrow making" (emphasis added) (A38).

Thus, it is apparent that the claimed invention is not limited to a single improved element and, consequently, the Petitioner's reliance on *Lincoln Engineering* is misplaced.

Petitioner intimates that the Court of Appeals erred in disregarding or failing to follow the *Lincoln Engineering* precedent. (Petition for Writ of Certiorari, Reasons for Granting Relief, numbered 1, 2 and 3.) This is a gross mischaracterization of the Federal Circuit's opinion as the Court neither "disregarded" nor "failed to follow" this leading case. Rather, the Court simply could not concur with Petitioner's assumption, critical to its *Lincoln Engineering* defense, that the channel-shaped portion of the cross brace is the essence of the invention and, therefore, the Court did not find *Lincoln Engineering* controlling. (A9)

CONCLUSION

There is overwhelming record support for the District Court's finding that the claims of the Tonelli '600 patent describe an "improved complete wheelbarrow" and, consequently, that the invention does not reside in any single limitation of the claims. In fact, there was absolutely no testimony adduced at trial supporting this latter contention. As a consequence, this Court's prior decision in *Lincoln Engineering* is inapposite and MTD's Petition inviting this Court to review same should be denied.

Respectfully submitted,

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